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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,120	07/18/2001	Dana Ault-Riche	25885-1751	1666

7590

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EXAMINER

TRAN, MY CHAU T

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 04/08/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,120

Applicant(s)

AULT-RICHE ET AL.

Examiner

My-Chau T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37,49-54,93-95 and 99 is/are pending in the application.
- 4a) Of the above claim(s) 49-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-37,93-95 and 99 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment filed 12/27/03 in Paper No. 11 is acknowledged and entered. Claims 34-48, 55-92, and 96-98 are canceled. Claim 99 is added. Claims 1-37, 93-95, and 99 are pending.
2. It is acknowledged that claim 95 was inadvertently not group with Group I, therefore it is now joined with Group I. Group I is now Claims 1-37, 93-95, and 99 (newly added claim).
3. It is noted that applicant indicate that Claims 96-98 were not group, but in fact Claims 96- 98 is Group XI (see top of page 3 of previous office action).
4. Applicant's election with traverse of Group I (Claims 1-37, 93-95, and 99) in Paper No. 11 is acknowledged.

The traversal is on the ground(s) that Group II (Claims 38-48 and 59) and Group III (Claims 49-54) should be rejoined with Group I, because claim 26 of Group I comprise of the oligonucleotides of claim 38 of Group II and claim 49 of Group III include the combination of Group I. Group VII (Claims 67-74) and Group IX (Claims 75-90) should be rejoined, because the oligonucleotide of claim 73 of Group VII is a generic of claim 75 of Group IX.

In regard to rejoining of Group III with Group I, this is not found persuasive because different patentability considerations are involved for each group. For example, a patentability there is determination for Group III would involve a determination of the patentability of a system (apparatus) while a patentability determination for Group I would involve a consideration

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of the patentability combination of the capture agents *and* the oligonucleotides. These considerations are very different in nature. Although there are some overlapping features (e.g. the combination of claim 1) among these inventions, Groups I and III, the search requirement for the “apparatus” is *not* coextensive that a search for one invention would *not encompass* the limitations of the other inventions thus resulting in divergent of the search evaluations.

Further, because applicant has cancelled claims 34-48, 55-92, and 96-98 and the argument is considered moot with regard to Group II, Group VII, and Groups IX.

However, the traversals are not persuasive. With regard to rejoining of Group II with Group I, there is different patentability considerations are involved for each group. For example, a patentability determination for Group II would involve a determination of the patentability of a set of oligonucleotides while a patentability determination for Group I would involve a consideration of the patentability combination of the capture agents *and* the oligonucleotides. These considerations are very different in nature.

The argument for rejoining Group VII and Group IX is not found persuasive because dependent claims (e.g. claim 73) of Group VII are *not* rely upon as criteria in the restriction requirement.

Therefore, the requirement is still deemed proper and is therefore made **FINAL**.

5. Claims 49-54 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11.

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6. Applicant's election with traverse of the species "A (1)" (e.g. oligonucleotide with the formula 5'-E_m-3') in Paper No. 11 is acknowledged. The traversal is on the ground(s) that the species (5'-E_m-3') is generic to the other two species because they include additional regions such as C or D_n. This is found persuasive and the species election requested has been withdrawn.

However, upon further reconsideration a proper species is required for the presently claimed invention.

Election/Restrictions

7. This application contains claims directed to the following patentably distinct species of the claimed invention.

8. Applicants are required to further elect *one single* species from a plurality of disclosed patentably distinct combination comprising:

- a. A capture agent.
- b. A specific oligonucleotide compound by defining the length of the oligonucleotide and its components (e.g. the target region; epitope region; divider region; a common region; and the point of attachment among these regions).

Applicant is advised that a response to the above election requirement should include an identification of the elected oligonucleotide components and the point of attachment to the capture agent with these requirements, and a listing of all claims readable thereon, including any claims subsequently added. If available, a drawing that corresponds to the elected oligonucleotide components should be provided to the Examiner in order to expedite the search

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of the elected compound species. An argument that all claims are generic is considered nonresponsive unless accompanied by an election.

9. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner is on ***Increased Flex Schedule*** and can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

mct
April 4, 2003


PADMASHRI PONNALURI
PRIMARY EXAMINER